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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,894	11/25/2000	Kia Silverbrook	NPA061US	4082
24011	7590	05/20/2004	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			HUYNH, THU V	
			ART UNIT	PAPER NUMBER
			2178	3

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,894

Applicant(s)

SILVERBROOK ET AL.

Examiner

Thu V Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: IDS filed on 03/19/2001; and application filed on 11/25/2000 which has foreign priority filed on 02/24/2000.
2. Claims 1-32 are pending in the case. Claims 1 and 17 are independent claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. The disclosure is objected to because of the following informalities:
Regarding specification pages 9-11, 15 and 19, information regarding earlier applications cited at these pages has not been updated.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 5-14, 17, 24-26, 28-30 rejected under 35 U.S.C. 102(b) as being anticipated by Levin et al., US 5,625,833 patented 1997.**

Regarding independent claim 1, Levin teaches a method of capturing, in computer system, data relating to a note-taking session, the session consisting of handwritten annotations made by a user by way of a writing implement on a plurality of pages, the method including the steps of:

- receiving, in the computer system and via the writing implement, an indication of the start of the note-taking session (Levin, col.9, lines 9-30; col.13, lines 1-15; col.18, lines 18-42; and figures 1a and 2a; receiving in the computer system and via writing implement, such as stylus, an indication to start a new annotation session);
- receiving, in the computer system and via the writing implement, data indicative of said handwritten annotations made by said user on said plurality of pages (Levin, col.3, lines 54-63; col.9, lines 9-30; col.20, lines 38-51 and figures 1a, 2a, 2e and 2f; receiving in the computer system and via writing implement, such as stylus, handwritten annotations made by a user on plurality of pages of a document);
- receiving, in the computer system and via the writing implement, an indicative of the end of the note-taking session (Levin, col.9, lines 9-30; col.19, lines 18-28; figures 1a and 2a; receiving in the computer system via writing implement, such as stylus an indication to end of a current annotation session); and
- retaining a retrievable record of the received data of the note-taking session (Levin, col.7, lines 5-28 and col.22, lines 2-8; the user is able to playback recorded annotation sessions).

Regarding dependent claim 5, which is dependent on claim 1, Levin teaches the limitations of claim 1 as explained above. Levin teaches wherein said indication of the start of the note-taking session is provided by the computer system receiving data indicative of said handwritten annotations made by said user on said plurality of pages (Levin, col.9, lines 9-30; col.13, lines 1-15; col.18, lines 18-42; and figures 1a and 2a; receiving in the computer system and via writing implement, such as stylus, an indication to start a new annotation session).

Regarding claim 6, which is dependent on claim 1, Levin teaches the limitations of claim 1 as explained above. Levin teaches wherein said plurality of pages are associated with a control portion comprising at least one control zone, the computer system receiving an indication via said writing implement that said user has designated one or more control zones using writing implement (Levin, col.20, lines 38-51; col.17, lines 31-42 and col.35, lines 13-15; using stylus to control at the end portion of a page, margin, or tabs of the plurality pages of a document).

Regarding claim 7, which is dependent on claim 6, Levin teaches the limitations of claim 6 as explained above. Levin teaches wherein one or more of said pages includes said control portion (Levin, col.20, lines 38-51; using stylus moves the “closefisted” cursor appear in a page to control portions of one or more pages of a document).

Regarding claim 8, which is dependent on claim 6, Levin teaches the limitations of claim 6 as explained above. Levin teaches wherein said plurality of pages is provided in the form of a notepad and the notepad includes said control portion on a part of the notepad other

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than on one of said pages (Levin, col.4, lines 1-14; col.17, lines 31-42; col.35, lines 13-15 and fig.2a, popup window 78 on a part of the notepad).

Regarding claim 9, which is dependent on claim 6, Levin teaches the limitations of claim 6 as explained above. Levin teaches wherein said at least one control zone includes a zone associated with the start of the note-taking session, and said indication of the start of the note-taking session is provided by the computer system receiving an indication that said user has designated zone by way of said writing implement (Levin, col.9, lines 9-30; col.13, lines 1-15; col.18, lines 18-42; and figures 1a and 2a; receiving in the computer system and via writing implement, such as stylus, an indication to start a new annotation session).

Regarding claim 10, which is dependent on claim 6, Levin teaches the limitations of claim 6 as explained above. Levin teaches wherein said at least one control zone includes a zone associated with the end of the note-taking session, and said indication of the end of the note-taking session is provided by the computer system receiving an indication that said user has designated zone by way of said writing implement (Levin, col.20, lines 38-55; using stylus to control a zone associated with the end of the annotation session when each page is treated in a separate annotation session).

Regarding claim 11, which is dependent on claim 1, Levin teaches the limitations of claim 1 as explained above. Levin teaches wherein said writing implement includes a writing nib, and said writing nib is associated with a sensor able to detect nib contact with one of said

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plurality of pages (Levin, col.9, lines 49-63; pressure sensor in the stylus “used in sensing the proximity of the writing tip end”).

Regarding claim 12, which is dependent on claim 1, Levin teaches the limitations of claim 1 as explained above. Levin teaches the step of using said retrievable record to selectively print the data indicative of said handwritten annotation (Levin, abstract and col.7, lines 40-60).

Regarding claim 13, which is dependent on claim 12, Levin teaches the limitations of claim 12 as explained above. Levin teaches wherein said plurality of pages is associated with a control portion including a zone associated with the printing of the note-taking session, the computer system receiving an indication via said writing implement that said user has designated said zone using the writing implement (Levin, col. 7, lines 40-60 and col.12, lines 41-49).

Regarding claim 14, which is dependent on claim 12, Levin teaches the limitations of claim 12 as explained above. Levin teaches wherein the data being printable on a plurality of pages corresponding to the plurality of pages annotated in the note-taking session (Levin, col.7, lines 40-60).

Claims 17, 24-26, 28-30 are for a computer system performing the method of claims 1, 6-8, 9-11, respectively and are rejected under the same rationale.

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. **Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levin as applied to claims 1 above, and further in view of Wolff et al., US 6,081,261, filed 1995.**

Regarding claim 2, which is dependent on claim 1, Levin teaches the limitations of claim 1 as explained above. Levin teaches wherein each of said pages includes coded data indicative of at least one reference point of the page (Levin, col.5, lines 5-28; col.17, lines 32-35; and col.22, lines 2-32; each page includes coded data references to original screen represented by a popup window indicative of at least one reference, such as “show ruler”, “playback” point of the page and writing implement, such as stylus activates the “show ruler” or “playback” option when the user “touch and lift” the stylus on such options) and said writing implement includes a sensor for sensing the proximity of the writing tip end (Levin, col.9, lines 49-63; pressure sensor in the stylus “used in sensing the proximity of the writing tip end”). However, Levin does not explicitly disclose the sensor for detecting said code data. However, Levin does not explicitly disclose a sensor for detecting said coded data.

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Wolff teaches annotating a document using writing implement, the document includes coded data, and writing implement includes a sensor for detecting said code data (Wolff, col.1, line 62 – col.2, line 2; col.2, line 43 – col.3, line 11; and col.4, lines 7-12).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Wolff and Levin to provide an input device that include a sensor for recognizing coded data, since this would have offer Levin's system to annotate different kinds of documents.

Regarding claim 3, which is dependent on claim 1, Levin teaches the limitations of claim 1 as explained above. Levin teaches wherein each of said pages includes coded data indicative of an identity of the page (Levin, col.5, lines 5-28; col.17, lines 32-35; and col.22, lines 2-32; each page includes coded data represented by a popup window indicative of an identity of the page) and said writing implement includes a sensor for sensing the proximity of the writing tip end (Levin, col.9, lines 49-63; pressure sensor in the stylus “used in sensing the proximity of the writing tip end”). However, Levin does not explicitly disclose the sensor for detecting said code data indicative of an identity of the page.

Wolff teaches annotating a document using writing implement, the document includes coded data page identification, and writing implement includes a sensor for detecting said code data (Wolff, col.1, line 62 – col.2, line 2; col.2, line 43 – col.3, line 11; col.4, lines 7-12; and col.4, lines 52-58).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Wolff and Levin to provide an input device that include a

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sensor for recognizing coded data identification, since this would have offer Levin's system to annotate different kinds of documents.

Regarding claim 4, which is dependent on claim 2 or claim 3, Levin teaches the limitations of claim 2 or claim 3 as explained above. Levin teaches wherein the coded data being substantially invisible in the visible spectrum (Levin, col.22, lines 32 and fig.2a, the coded data does not show on the page and invisible for the user).

9. Claims 15 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levin as applied to claims 1 and 17 above, and further in view of Tonkin et al., US 6,616,702 B1, priority filed 1998.

Regarding claim 15, which is dependent on claim 14, Levin teaches the limitations of claim 14 as explained above. Levin does not explicitly disclose binding plurality of printed pages.

Tonkin teaches a system allows a user specifies a binding type via stylus to binding plurality of printed pages (Tonkin, col.2, lines43-63; col.4, lines 63-67; and col.10, lines 35-49).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Tonkin and Levin to bind plurality of printed pages of a document together, since this would have offered more features for the print function.

Claim 31 is for a computer system performing the method of claim 15 and is rejected under the same rationale.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levin as applied to claims 1 above, and further in view of Wolff et al., US 6,081,261, filed 1995, and Moran et al., US 5,717,879, patented 1998.

Regarding claim 16, which is dependent on claim 1, Levin teaches the limitations of claim 1 as explained above. Levin does not explicitly disclose that the writing implement contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user in said note-taking session and in which the method includes monitoring, in the computer system, said identity.

Wolff teaches that a writing implement contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user in said note-taking session (Wolff, col.1, line 62 – col.2, line 2; col.2, line 43 – col.3, line 11; and col.10, lines 34-38).

Wolff does not explicitly disclose monitoring said identity in the computer system.

Moran teaches tracking color coded to identify the person in a meeting who annotated on a whiteboard and playing back the meeting session (Moran, col.3, lines 12-23; col.5, lines 19-33 and col.22, lines 8-21)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Moran into Wolff and Levin to identify persons during annotation session, since this would have supported workgroup meeting using pen based annotation environment.

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11. Claims 18-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levin as applied to claim 17 above, and further in view of Copperman et al., US 6,665,490 B2, filed 1999.

Regarding claim 18, which is dependent on claim 17, Levin teaches the limitations of claim 17 as explained above. Levin teaches wherein each page includes coded data indicative of at least one references point of the page (Levin, col.5, lines 5-28; col.17, lines 32-35; and col.22, lines 2-32; each page includes coded data references to particular original screen represented by a popup window indicative of at least one reference, such as “show ruler”, “playback” point of the page and writing implement, such as stylus activates the “show ruler” or “playback” option when the user “touch and lift” the stylus on such options).

However, Levin does not explicitly disclose said indicating data regarding the position of the writing implement relative to a page being sensed by the writing implement using at least some of coded data.

Copperman teaches coded data indicating position of a writing implement relative to a page for playback playback annotation portion (Copperman, col.6, lines 44-59 and col.13, lines 15-22, annotation ID stored with the timestamp used for playback annotation portion).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Copperman and Levin to provide data regarding location of annotation as Copperman’s annotation ID, since this would have facilitate the system retrieves as well as plays back annotation portions.

Regarding claim 19, which is dependent on claim 18, Levin and Copperman teach the limitations of claim 18 as explained above. Levin teaches wherein each page includes coded data indicative of an identity of the page as explained in claim 18 above. Refer to the rationale relied to reject claim 18, the limitation of “said indicating data regards both the position of the writing implement relative to a page and identify of the page” is included. The rationale is incorporated herein.

Regarding claim 20, which is dependent on claim 18, Levin and Copperman teach the limitations of claim 18 as explained above. Levin teaches wherein the coded data is substantially invisible in the visible spectrum (Levin, col.22, lines 32 and fig.2a, the coded data does not show on the page and invisible for the user).

Regarding claim 22, which is dependent on claim 18, Levin and Copperman teach the limitations of claim 18 as explained above. Levin teaches wherein said writing implement includes a writing nib, and said writing nib is associated with a sensor able to detect nib contact with one of said plurality of pages (Levin, col.9, lines 49-63; pressure sensor in the stylus “used in sensing the proximity of the writing tip end”).

12. **Claims 21 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levin further in view of Copperman as applied to claim 18 as explained above, and further in view of Wolff et al., US 6,081,261, filed 1995.**

Regarding claim 21, which is dependent on claim 18, Levin and Copperman teach the limitations of claim 18 as explained above. Levin does not explicitly disclose a writing implement which includes sensor for detecting said coded data.

Wolff teaches annotating a document using writing implement, the document includes coded data page identification, and writing implement includes a sensor for detecting said code data (Wolff, col.1, line 62 – col.2, line 2; col.2, line 43 – col.3, line 11; col.4, lines 7-12; and col.4, lines 7-12 and lines 52-58).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Wolff and Levin to provide an input device that include a sensor for recognizing coded data identification, since this would have offer Levin's system to annotate different kinds of documents.

Regarding claim 32, which is dependent on claim 18, Levin and Copperman teach the limitations of claim 18 as explained above. Levin teaches providing typed annotations with coded data for a printer buffer for printing an annotation document (Levin, col.7, lines 40-60, providing respective position relative to the document to a printer buffer for printing the annotation document). However, Levin does not explicitly disclose a printer for printing the coded data on the plurality of pages.

Wolff teaches coded data that identifies document pages is printed on plurality of pages for identify each document pages (Wolff, abstract, col.3, lines 37-41).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Wolff and Levin to print coded data on the plurality page, since this would have provide information to identify the document.

13. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levin further in view of Copperman and Wolff as applied to claim 21 as explained above, and further in view of Moran et al., US 5,717,879, patented 1998.

Regarding claim 23, which is dependent on claim 21, Levin, Copperman, Copperman and Wolff teach the limitations of claim 21 as explained above. Levin does not explicitly disclose that the writing implement contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user in said note-taking session and in which the method includes monitoring, in the computer system, said identity.

Wolff teaches that a writing implement contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user in said note-taking session (Wolff, col.1, line 62 – col.2, line 2; col.2, line 43 – col.3, line 11; and col.10, lines 34-38).

Wolff does not explicitly disclose monitoring said identity in the computer system.

Moran teaches tracking color coded to identify the person in a meeting who annotated on a whiteboard and playing back the meeting session (Moran, col.3, lines 12-23; col.5, lines 19-33 and col.22, lines 8-21)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Moran into Wolff and Levin to identify persons during

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annotation session, since this would have supported workgroup meeting using pen based annotation environment.

14. ^{27 3} ~~Claims~~ rejected under 35 U.S.C. 103(a) as being unpatentable over Levin as applied to claim 21 as explained above, and in view of Moran et al., US 5,717,879, patented 1998.

Regarding claim 27, which is dependent on claim 26, Levin teaches the limitations of claim 26 as explained above. Levin does not explicitly disclose said plurality of pages being superposed and joined together on a backing sheet, the backing sheet sized to extend beyond at least one edge of the superposed plurality of pages to provide an uncovered extended part, said control portion being provide on said extended part of the backing sheet.

Moran teaches annotation on plurality of pages that being superposed and joined together on a backing sheet, the backing sheet sized to extend beyond at least one edge of the superposed plurality of pages to provide an uncovered extended part, said control portion being provide on said extended part of the backing sheet (Morran, col.3, lines 13-23; col.25, lines 10-23; col.14, lines 25-47; and fig.15, annotations documents on an electronic whiteboard).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Moran and Levin to annotate documents in a meeting environment, since whiteboard is used in record and playback annotation portion.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yamade et al., US 5,959,615, filed 1997, teaches information processing device setting a color for scheduled item by a pen.

Buckley et al., US 6,446,871 B1, filed 1999, teaches method for storing reference codes in writing instrument and for retrieving information identified by the reference codes.

Chiu et al., US 6,452,615 B1, filed 1999, teaches system for notetaking with digital video and ink.

Lamming, US 5,535,063, filed 1995, teaches note-taking system based on a notepad computer.

Schrock et al., US 5,845,161, filed 1997, teaches stylus based electronic annotation camera.

Maruo et al., US 5,432,525, filed 1990, teaches identifying the other party of the meeting in pen-based environment.

Cook et al., US 6,201,948 B1, filed 1998, teaches agent based instruction system.

Katsurabayashi et al., US 5,996,002, filed 1997, teaches collaborative work support system and method to facilitate the process of discussion in a meeting using a shared window.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is 703-305-9774. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH

May 10, 2004